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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/306,111 05/06/99 JACOBS

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025291 HM12/0718
AMERICAN HOME PRODUCTS CORPORATION
PATENT SECTION
FIVE GIRALDA FARMS
MADISON NJ 07940-0874

EXAMINER

BRUSCA, J

ART UNIT

PAPER NUMBER

1631

12

DATE MAILED: 07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/306,111

Applicant(s)

JACOBS ET AL.

Examiner

John S. Brusca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/23/01 (interview summary).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group 1 and the sequence of clone er311_20 as noted in the election received 08 December 2000 as corrected in the interview summary of 21 May 2001 is acknowledged.

Information Disclosure Statement

2. References A12 and A13 in the Form PTO 1449 received 23 May 2001 were not considered because the references are not publications.

Claim Objections

3. Claims 7 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims are dependent on cancelled claim 6. For the purpose of examination claim 7 has been treated as being drawn to a polynucleotide that is a fragment of SEQ ID NO:21, and claim 8 has been treated as being drawn to an isolated polynucleotide encoding the complete polypeptide encoded by clone er311_20.

Priority

4. It is brought to the applicant's attention that for the purposes of examination priority has not been granted to the claimed provisional applications for the elected invention because it has not been determined that the elected invention was disclosed in the claimed provisional applications. The claimed provisional applications were not filed with a sequence listing or computer readable form of the sequence listing. As such, the Office is not able to determine

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whether the elected invention was disclosed in the claimed provisional applications. Prior art published after the claimed provisional applications but before the filing date of the instant application has been cited in this Office action. The applicants are requested to provide evidence that the elected invention is disclosed in the claimed provisional applications if they wish to contest the citation of the intervening prior art.

5. The priority statement in the first sentence of the specification is objected to because it states that the instant application is a continuation-in-part of a series of provisional applications, because a continuation-in-part must claim priority to a non-provisional parent application (see MPEP 201.08). The first sentence should be amended to state that the instant application **claims the benefit of** the series of provisional applications (see MPEP 201.11).

Specification

6. The disclosure is objected to because of the following informalities: On page 1 there is a certificate of mailing statement which should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC 101 and 112

Definitions: [from REVISED INTERIM UTILITY GUIDELINES TRAINING MATERIALS; repeated from <http://www.uspto.gov/web/menu/utility.pdf>]

"Credible Utility" - Where an applicant has specifically asserted that an invention has a particular utility, that assertion cannot simply be dismissed by Office personnel as being "wrong". Rather, Office personnel must determine if the assertion of utility is credible (i.e., whether the assertion of utility is believable to a person of ordinary skill in the art based on the totality of evidence and reasoning provided). An assertion is credible unless (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based is inconsistent with the logic underlying the assertion. Credibility as used in this context refers to the reliability of the statement based on the logic and facts that are offered by the applicant to support the assertion of utility. A *credible* utility is assessed from the standpoint of whether a person of ordinary skill in the art would accept that the recited or disclosed invention is currently available for such use. For example, no perpetual motion machines would be considered to be currently available. However, nucleic acids could be used as probes, chromosome markers, or forensic or diagnostic markers. Therefore, the credibility of such an assertion would not be questioned, although such a use might fail the *specific* and *substantial* tests (see below).

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"Specific Utility" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention. For example, a claim to a polynucleotide whose use is disclosed simply as a "gene probe" or "chromosome marker" would not be considered to be *specific* in the absence of a disclosure of a specific DNA target. Similarly, a general statement of diagnostic utility, such as diagnosing an unspecified disease, would ordinarily be insufficient absent a disclosure of what condition can be diagnosed.

"Substantial utility" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. For example, both a therapeutic method of treating a known or newly discovered disease and an assay method for identifying compounds that themselves have a "substantial utility" define a "real world" context of use. An assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular disease condition would also define a "real world" context of use in identifying potential candidates for preventive measures or further monitoring. On the other hand, the following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use and, therefore, do not define "substantial utilities":

- A. Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved.
- B. A method of treating an unspecified disease or condition. (Note; this is in contrast to the general rule that treatments of specific diseases or conditions meet the criteria of 35 U.S.C. ' 101.)
- C. A Method of assaying for or identifying a material that itself has no "specific and/or substantial utility".
- D. A method of making a material that itself has no specific, substantial, and credible utility.
- E. A claim to an intermediate product for use in making a final product that has no specific, substantial, and credible utility.

Note that "throw away" utilities do not meet the tests for a *specific* or *substantial* utility. For example, using transgenic mice as snake food is a utility that is neither specific (all mice could function as snake food) nor substantial (using a mouse costing tens of thousands of dollars to produce as snake food is not a "real world" context of use). Similarly, use of any protein as an animal food supplement or a shampoo ingredient are "throw away" utilities that would not pass muster as specific or substantial utilities under 35 U.S.C. ' 101. This analysis should, of course, be tempered by consideration of the context and nature of the invention. For example, if a transgenic mouse was generated with the specific provision of an enhanced nutrient profile, and disclosed for use as an animal food, then the test for specific and substantial *asserted* utility would be considered to be met.

A "Well established utility" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art. "Well established utility" does not encompass any "throw away" utility that one can dream up for an invention or a nonspecific utility that would apply to virtually every member of a general class of materials, such as proteins or DNA. If this is the case, any product or apparatus, including perpetual motion machines, would have a "well established utility" as landfill, an amusement device, a toy, or a paper weight; any carbon containing molecule would have a "well established utility" as a fuel since it can be burned; any protein would have well established utility as a protein supplement for animal food. This is not the intention of the statute.

See also the MPEP at 2107 - 2107.02.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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2. Claims 1-5, 7, and 8 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The claimed nucleic acid compounds are not supported by a specific asserted utility because the disclosed uses of the nucleic acids or encoded proteins are not specific and are generally applicable to any nucleic acid and/or protein. The specification does not state a specific utility for which the claimed nucleic acids or encoded proteins may be used. While the claimed nucleic acid compounds may be useful as probes for assisting in the isolation of full-length cDNAs or genes which would be used to make protein and optionally further usage to make the corresponding antibodies, gene mapping, isolation of homologous sequences, detection of gene expression such as in Northern blot analysis, molecular weight markers, chromosomal markers, and for numerous other generic genetic engineering uses, such uses are not specific and could apply to any nucleic acid. Similarly, the encoded protein might be used for detection of expression, antibody production, Western blots, etc., but these are non-specific uses that are applicable to all proteins and are not particular or specific to the encoded protein of the nucleic acids being claimed.

Further, the claimed nucleic acid and/or protein compound are not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. For example, a nucleic acid may be utilized to obtain a protein. The protein could then be used in conducting research to functionally characterize the protein. The need for such research clearly indicates that the protein and/or its function is not disclosed as to a currently available or substantial utility. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a

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specific and substantial utility. In this case, none of the proteins that are to be produced as final products resulting from processes involving claimed nucleic acids have specific and substantial utilities. The research contemplated by applicants to characterize potential protein products, especially their biological activities, does not constitute a specific and substantial utility.

Identifying and studying the properties of a protein itself or the mechanisms in which the protein is involved does not define a "real world" context or use. Similarly, the other listed and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and applicable to a myriad of such compounds. Note, because the claimed invention is not supported by a specific and substantial asserted utility for the reasons set forth above, credibility of the utility has not been assessed. Neither the specification as filed nor any art of record discloses or suggests any property or activity for the nucleic acid and/or protein compounds such that another non-asserted utility would be well established for the compounds.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5, 7, and 8 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

5. Claims 1-5, 7, and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

The specification discloses a polynucleotide listed in SEQ ID NO: 21 and the corresponding encoded polypeptide listed in SEQ ID NO:22 and the corresponding deposited polynucleotide clone er311_20 which corresponds to a human fetal brain cDNA. SEQ ID NO: 21 and 22 and clone er311_20 meet the written description provisions of 35 USC 112, first paragraph. However, because it is not apparent that SEQ ID NO:21 and 22 and clone er311_20 comprises a complete open reading frame, claims 1-5, 7, and 8 are directed to encompass gene sequences and complete cDNA sequences. Evidence that SEQ ID NO:21 is not a complete open reading frame is provided in the attached lineup of SEQ ID NO:21 against GenBank Version Number AK001486.1, which shows a human cDNA clone which comprises additional 437 nucleotides that are 5' sequences relative to the first nucleotide of SEQ ID NO:21. In addition, the specification states on page 198 that clone er311_20 encodes a polypeptide of 91 kDa, while the sequence disclosed in SEQ ID NO:22 consists of only 667 amino acids, which at an average molecular weight of 110 Da per amino acid would encode a polypeptide of only 73 kDa. The claims further encompass sequences that hybridize or are similar to SEQ ID NO: 21, corresponding sequences from other species, mutated sequences, allelic variants, splice variants, sequences that have a recited degree of identity (similarity, homology), and so forth. None of these sequences meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

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Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

With the exception of SEQ ID NO: 21, 22, and clone er311_20, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993), and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by structure, formula, chemical

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name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." *Id.* at 1170, 25 USPQ2d at 1606.

The name cDNA is not itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA. Describing a method of preparing a cDNA or even describing the protein that the cDNA encodes, as the example does, does not necessarily describe the cDNA itself. No sequence information indicating which nucleotides constitute human cDNA appears in the patent, as appears for rat cDNA in Example 5 of the patent. Accordingly, the specification does not provide a written description of the invention of claim 5.

Therefore, only SEQ ID NO: 21, 22, and clone er311_20 but not the full breadth of the claim meets the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by PCT publication number WO9845436.

The claim is drawn to a fragment of a polynucleotide listed in SEQ ID NO:21.

The attached lineup shows that positions 2-288 of a polynucleotide disclosed in WO9845436 (published 15 October 1998) has 100% similarity with positions 1550-1836 of SEQ ID NO:22.

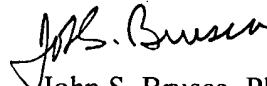
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday -Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-5137 for regular communications and (703) 746-5137 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


John S. Brusca, Ph.D.
Primary Examiner
Art Unit 1631

jsb
July 13, 2001